

said predefined indicia on a first page, removing said panel comprising user-defined indicia and inserting said panel comprising user-defined indicia into a second pocket.

31-34. (canceled)

REMARKS

In the Office Action, the Examiner noted that the indication of allowable subject matter in the November 8, 2006 Office Action was withdrawn in light of the rejections in the present Office Action.

The Examiner then rejected Claims 1, 3-19, 21, 22, 26-27 and 29-30 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner found the phrase “one half of a first whole sheet...one half of a second whole sheet” to be unclear. In response, Applicant respectfully requests reconsideration of this ground of rejection.

More particularly, Applicant avers that the phrasing is not unclear, with support being found at, *inter alia*, page 5, line 8 – page 6, line 23 of the specification as filed. In this regard, all that is meant is that parts of two separate sheets of paper are required in order to form one leaf with a pocket. In this regard, a first sheet of paper is folded in half with one half of that folded first sheet being used as the front wall and that a second sheet of paper is also folded in half with one half of that folded second sheet being used as a back wall. Notwithstanding, Applicant is amending Claims 1 and 5 in order to more particularly point out and define the claimed invention. No new matter is added by this amendment and support can be found at, *inter alia*, page 5, line 8 – page 6, line 23 of the specification as filed. Therefore, Applicant respectfully requests reconsideration and removal of this ground of rejection.

The Examiner then rejected Claims 1, 3, 6-10 and 12-14 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,055,118 to Betancourt. In response, Applicant has amended Claim 1 to more particularly point out how the pocket of the invention is formed. In contrast, Betancourt does not teach that different pages are bound together to form a pocket in the manner of the present invention. Therefore, Applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected Claims 1, 3-5, 6, 7, 15-18, 21-22 and 26-27 under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,141,253 to Rice. In response, Applicants have amended Claims 1 and 5 to more particularly point out how the pocket of the invention is formed. In contrast, Rice teaches a much different way of making a leaf which uses only one sheet of paper (see, e.g., FIG. 2) and does not carry the same benefits as Applicant's invention. Therefore, Applicant respectfully requests removal of this ground of rejection.

The Examiner next rejected Claim 4 under 35 U.S.C. §103(a) as being unpatentable over Betancourt in view of U.S. Pat. No. 2,944,356 to Anthon. In response, and based on the above-discussed amendments, Applicant avers that it would not be obvious to combine the Betancourt reference with the Anthon reference in order to create that which Applicant claims as the invention.

More particularly, Betancourt is directed towards an educational device in the form of a book (Col. 1, lines 8-13); Anthon teaches transparency equipment and filing and viewing devices to view transparencies (Col. 1, lines 15-18). Anthon presumably is concerned with old-style projector slides, movie-reel film, and/or photographic negatives (Col. 2, lines 14-16 and 32-58 and Col. 3, lines 35-51). It would not be obvious to one of skill in the art of educational devices

to combine teachings with the art of viewing and storing film negatives that require an additional source of light underneath the negatives.

Even if it would be obvious to combine the two references (which it is not), that which Applicant claims as the invention still would not be created. In this regard, Claim 1 as amended (from which Claim 4 depends) requires that two sheets of paper be used to create one leaf with a pocket. In contrast, and as discussed above, Betancourt does not teach that different pages are bound together to form a pocket. Anthon does not cure this deficiency because it also teaches using only one piece of paper to make each leaf (see, e.g., FIG. 10), thus Applicant's invention would not be created even by the impermissible combination of the two references. Therefore, Applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected Claims 9-10 under 35 U.S.C. §103(a) as being unpatentable over Rice in view of U.S. Pat. No. 6,244,628 to Muller. In response, Applicant avers that it would not be obvious to one of skill in the art to combine the teaching of Rice with the disclosure of Muller in order to create that which Applicant claims as the invention.

More particularly, Rice is directed towards an advertisement display for use in second-class mailings which are subject to very stringent requirements (Col. 1, lines 9-40); Muller is concerned with "a system and method for very conveniently and quickly locating various topics found in the Bible" (Col. 1, lines 10-13). It would not be obvious to one of skill in the advertising arts to combine teachings with the art of locating and teaching biblical passages.

Even if it were obvious to combine the two references (which it is not), that which Applicant claims as the invention still would not be created. In this regard, Claim 1 requires that two sheets of paper be used to create one leaf with a pocket. As discussed above, Rice teaches only using one sheet of paper to create a leaf. Muller cannot cure this deficiency because Muller

discusses only books already known in the art (e.g., the Bible) which uses the conventional norm of one sheet per leaf. Therefore, Applicant respectfully requests removal of this ground of rejection.

Next, the Examiner rejected Claim 11 under 35 U.S.C. §103(a) as being unpatentable over Rice in view of U.S. Patent No. 2,438,048 to Graham or U.S. Patent No. 893,353 to McGill. In response, and based on the above-discussed amendments, Applicant avers that it would not be obvious to combine the Rice reference with either the Graham or McGill references in order to create that which Applicant claims as the invention.

More particularly, and as discussed above, Rice is directed towards an advertisement display for use in second-class mailings which are subject to very stringent requirements (Col. 1, lines 9-40); Graham is directed towards a bookmark that can be inserted into the binding of a book (Col. 1, lines 1-11); and McGill is directed towards a type of paperclip (Col. 1, lines 9-20 and Figs. 1-11). It would not be obvious to one of skill in the advertising arts to combine teachings with the art of 1) temporarily holding a place in a book, or 2) fastening sheets of paper together.

Even if it were obvious to combine Rice with either Graham or McGill (which it is not), that which Applicant claims as the invention still would not be created. In this regard, Claim 1 as amended requires that two sheets of paper be used to create one leaf with a pocket. As discussed above, Rice teaches only using one sheet of paper to create a leaf. Neither Graham nor McGill cure this deficiency because neither reference teaches how to form pages into a book. Therefore, Applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected Claim 19 under 35 U.S.C. §103(a) as being unpatentable over Rice or Betancourt in view of U.S. Patent No. 5,951,298 to Werzberger. In response, and

based on the above-discussed amendments, Applicant avers that it would not be obvious to combine the Rice or Betancourt references with the Werzberger reference in order to create that which Applicant claims as the invention.

More particularly, and as discussed above, Rice is directed towards an advertisement display for use in second-class mailings which are subject to very stringent requirements (Col. 1, lines 9-40); Betancourt is directed towards an educational device in the form of a book (Col. 1, lines 8-13); and Werzberger is directed towards instructional or educational book assemblies (Col. 1, lines 13-15). It would not be obvious to one of ordinary skill in the art of advertisements to combine the teaching with teachings in the art of educational activities.

Even if it were obvious to combine the teachings of either Rice or Betancourt with the teaching of Werzberger, that which Applicant claims as the invention still would not be created. In this regard, Claim 1 as amended requires that two sheets of paper be used to create one leaf with a pocket. As discussed above, Rice teaches only using one sheet of paper to create a leaf. Betancourt does not teach using two sheets of paper to create one leaf with a pocket either. Werzberger teaches using only one sheet of paper per leaf with each paper being bound at a communal seam (Col. 9, lines 8-10). Thus, any combination of the three references still would not create that which Applicant claims as the invention. Therefore, Applicant respectfully requests removal of this ground of rejection.

The Examiner also rejected Claims 29-30 under 35 U.S.C. §103(a) as being unpatentable over Betancourt in view of Anthon and further in view of U.S. Patent No. 1,099,188 to Mealand. In response, Applicant avers that it would not be obvious to one of skill in the art to combine the teaching of Betancourt with the disclosures of Anthon and Mealand in order to create that which Applicant claims as the invention.

More particularly, and as discussed above, Betancourt is directed towards an educational device in the form of a book (Col. 1, lines 8-13); Anthon teaches transparency equipment and filing and viewing devices to view transparencies (Col. 1, lines 15-18). Anthon presumably is concerned with old-style projector slides, movie-reel film, and/or photographic negatives (Col. 2, lines 14-16 and 32-58 and Col. 3, lines 35-51). Mealand is concerned with novelty entertainment devices in the form of books (Col. 1, lines 1-26). It would not be obvious to one of skill in the art of educational devices to combine teachings with the art of viewing and storing film negatives that require an additional source of light underneath the negatives and further with the art of novelty entertainment.

Even if it would be obvious to combine the three references (which it is not), that which Applicant claims as the invention still would not be created. In this regard, Claim 1 as amended requires that two sheets of paper be used to create one leaf with a pocket. As discussed above, neither Betancourt or Anthon teach using two sheets of paper to create one leaf with a pocket. Mealand does not cure this deficiency because it teaches only folding one piece of paper in half to be used as the leaf with a pocket (Col. 1, lines 39-46). Thus, Applicant's invention would not be created even by the impermissible combination of the three references. Therefore, Applicant respectfully requests removal of this ground of rejection.

Finally, the Examiner rejected Claims 1 and 5 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,540,260 to Tan in view of U.S. Patent No. 5,947,522 to Boehm. In response, Applicant respectfully requests reconsideration and removal of this ground of rejection based upon the amendments to Claims 1 and 5.

More particularly, Applicant avers that it would not be obvious to one of skill in the art to combine the teaching of Tan with the disclosure of Boehm in order to create that which

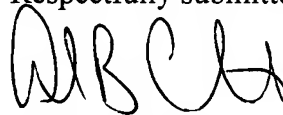
Applicant claims as the invention. In this regard, Tan relates to a photograph album page and ways to display photographs in an album (Col. 1, lines 19-23); Boehm relates to a theme-based scrap book album containing many folders (Col. 1, lines 38-40). Photography is a skill requiring a keen eye for detail as well as good aesthetic sensibilities. In contrast, scrap booking requires great forethought in deciding what trinkets may be important as souvenirs of the past and artfully arranging those trinkets. Additionally, Boehm actively teaches away from the combination of the two references: Boehm teaches that an aperture can only be “[l]ocated in an upper part of the outer half portion” (Col. 4, line 44) whereas Tan teaches apertures on both pages (see, e.g., Fig. 1).

Even if it were obvious to combine the two references (which it is not), that which Applicant claims as the invention still would not be created. In this regard, Claims 1 and 5 as amended that two sheets of paper be used to create one leaf with a pocket. In contrast, Tan teaches that only one sheet of paper is used to create a leaf (see, e.g., Figs. 5, 6 and 7 and Col. 5, line 43 – Col. 6, line 5). Boehm does not cure this deficiency because Boehm also teaches that only one sheet of paper is used to create a leaf (see, e.g., Figs. 4 and 6 and Col. 3, lines 45 – 57).

Thus, Applicant’s invention would not be created even by the impermissible combination of the two references. Therefore, Applicant respectfully requests removal of this ground of rejection.

Based on the above, Applicant respectfully submits that the claims of the present invention are in proper form for allowance. Favorable consideration and early allowance are therefore respectfully requested and earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'A B Clement', written in a cursive style.

Alan B. Clement
Reg. No. 34,563

MAILING ADDRESS

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036
(212) 302-8989